

REMARKS

Claims 1-17 are pending in this application. Due to a restriction requirement claims 7-11 and 13-17 are withdrawn from consideration and claims 1-6 and 12 are rejected. In response, Applicants have amended claim 1 and cancelled claim 2. Applicants' response to the Examiner's rejection is as follows.

I. The Restriction Requirement Under 35 U.S.C. §121

The Examiner required restriction of the claims to one of the following categories:

Group I: claims 1-6, drawn to butanoic acids. Linking method claims 10-14 may be considered together upon the election of a single disclosed method of use (one specific disorder) with compounds in claims 1-6.

Group II: claims 7-8, drawn to a composition containing compounds of group I and another antineoplastic agent

Group III: claim(s) 15-16, drawn to a method of inhibiting tumor growth with another antineoplastic agent.

Group IV: claim(s) 9, 17 drawn to a composition and a method of treating osteoporosis with another inhibitor of bone resorption.

The Examiner maintains that the above grouping is proper because each of the groups is drawn to patentably distinct inventions.

The Applicants assert that even though vitronectin receptor is expressed on a number of different cells, antagonists of vitronectin inhibit the receptor through the same mechanism regardless of the type of cell the receptor is found. Therefore, it is possible to claim the instant compounds, compositions, and methods of use in a single application because the compounds inhibit vitronectin through the same mode of action. Also, because the compounds and compositions arose from a singular research effort, the claims should be considered as parts of a single application. In view of these remarks, the Applicants respectfully request that the requirement be reconsidered and withdrawn.

However, Applicants affirm the provisional election made with traverse on April 16, 2003, to prosecute the invention of Group I for treating osteoporosis claims 1-6 and 12.

Applicants traverse the restriction requirement on the ground that the inventions of the claims as grouped by the Examiner are not independent, but Applicants do not traverse this requirement on the ground that these inventions are not patentably distinct. Thus, Applicants are not aware of any evidence that the claims are obvious variants of each other and specifically deny that the inventions of any groups of claims are obvious variants of the inventions of any other groups of claims.

II. Rejection Under 35 U.S.C. §102(e)

Claims 1-6 are provisionally rejected under 35 U.S.C. §102(e) as being anticipated by copending application No. 10/023,471, which has a common inventor with the instant application. The Examiner states that based upon the earlier effective filing date of the copending application, it would constitute prior art under 35 U.S.C. §102(e), if published under 35 U.S.C. §122(b) or patented. Applicants will address this rejection when copending application No. 10/023,471 is either published under §122 or patented.

III. Rejection Under 35 U.S.C. §101

Claims 1-6 are provisionally rejected under 35 U.S.C. §101 as claiming the same invention as that of elected claims of copending Application No. 10/023, 471. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. Applicants will address this rejection when the conflicting claims have been patented.

IV. Rejection Under 35 U.S.C. §102(g) and §102(f)

Claims 1-6 are directed to the same invention as that of claims of commonly assigned SN 10/023,471. The Examiner states that the issue of priority under 35 U.S.C. §102(g) and possibly 102(f) of this single invention must be resolved. Applicants state that the instant application and 10/023,471 are assigned to a common assignee (SmithKline Beecham Corporation) and that the applications contain work from three common inventors. Applicants state the inventive entity of Miller, Gleason, Heerding, Samanen, Uzinskas, and Manley are the prior inventors of the conflicting subject matter. Furthermore, Applicants have amended claim 1 so that it incorporates the limitations of claim 2. Thus, there is no longer conflicting subject matter between the claims

of the instant application and 10/023,471. In light of the above amendments to the claims, Applicants respectfully request the rejection under §102(g) and §102(f) be reconsidered and withdrawn.

V. Rejection Under 35 U.S.C. §103(a)

Claims 1-6 are provisionally rejected under 35 U.S.C. §103(a) as being obvious over copending application No. 10/023,471 which has a common inventor with the instant application. The provisional rejection under 35 U.S.C. §103(a) is based upon the presumption of future publication or patenting of the conflicting application. Applicants will address this issue when the conflicting application has in fact been patented or published.

VI. Obviousness Type Double Patenting Rejection

Claims 1-6 are provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims of copending Application No. 10/023,471. The Examiner states that although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed compounds are analogous to each other. Applicants will address this rejection when subject matter is found to patentable.

VII. Rejection Under 35 U.S.C. §112, second paragraph

Claim 1 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Examiner states that the term "het" is ambiguous and indefinite. Applicants submit the claims should be read in light of the definitions given in the specification. On pages 6-7 of the specification, the term "het" is clearly defined. However, solely in order to expedite prosecution of this application, Applications have amended claim 1 so that it incorporates the limitations of claim 2. In light of the above amendment to claim 1, Applicants request that the rejection be withdrawn.

VIII. Rejection Under 35 U.S.C §102(a,e)

Claim 6 is rejected under 35 U.S.C. § 102(a,e) as being anticipated by US20020147334. Applicants have amended claim 1 so that it now incorporates the limitations of claim 2. In light of the amendment made to claim 1, Applicants request that the rejection under §102(a,e) be reconsidered and withdrawn.

IX. Conclusion

This reply is intended to respond to every ground of objection and rejection, and to advance this case to allowance. In view of the above amendments and remarks, reconsideration of this application is requested. Should the Examiner have any questions or wish to discuss any aspect of this case, the Examiner is encouraged to call the undersigned agent at the number below.

Respectfully submitted,



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